

**Status of the Claims**

Claims 1-16 are canceled.

Claims 17 -20 are pending.

Claims 17-20 have not been amended.

**§102(b) Rejection - Seelig**

Claims 17-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,560,603 to Seelig et al. (“Seelig” hereinafter). This rejection is respectfully traversed.

Claim 17 recites a method for directing a gaming device comprising, inter alia, “determining a first event that occurs during play of a gaming device; determining a first payout for the first event; providing the first payout to a player associated with the first event; determining a second event that occurs during play of the gaming device, the second event occurring at a time after a time at which the first event occurs; determining a second payout for the first event, based on the subsequent occurrence of the second event; and providing the second payout to a player associated with the first event, thereby providing a retroactive payout for the first event.”

Seelig does not disclose, teach or suggest these limitations, particularly “determining a second payout for the first event, based on the subsequent occurrence of the second event;” and “providing the second payout to a player associated with the first event, thereby providing a retroactive payout for the first event.”

Every payout of Seelig is associated with its own event. Once a payout has been made in Seelig, there is no opportunity for a second payout

to be made for that same event. In the preferred embodiment of Seelig, the payout for the second events (winning a racing game) are specifically described as not overlapping with the first events (winning a conventional slot game) whatsoever.

The Office Action relies on large portions of Col. 3:5-4:7 of Seelig as disclosing the claimed method, but does not identify with specificity what elements of Seelig correspond to the limitations of claim 17. The cited portions of Seelig are discussed in detail below. As the discussion will make clear, the cited portion of Seelig does not disclose the claimed limitations.

### **Seelig Describes a Primary Slot Game and a Secondary Racing Game**

#### **Section A (Col. 3:5-31) of Seelig: Secondary Racing Game**

Describing Fig. 1, Section A of Seelig recites a racing game having a timer display 24 on a slot machine 10, arranged to count down (Col. 3:5-12); and a racing game display 20 having “Win,” “Place” and “Show” markings (Col. 3:13-18). Col. 3:19-31 describes utilizing the slot machine in a conventional manner, wherein the initiating play via a button 16 or lever 14 starts the timer display 24, counting down from a set time, e.g., five minutes. Initiation of play or, alternatively, pressing a separate button, resets a racing element 22, e.g., a horse, to the start position.

#### **Section B (Col. 3:32-39): Conventional Primary Game with Conventional Payout**

Section B of Seelig describes paying out coins to a player in response to a conventional winning outcome, e.g., the rotating wheels 10 stopping on a winning combination.

#### **Section C (Col. 3:40-55): Play of the Secondary Racing Game**

Section C of Seelig describes advancing the racing element 22 in response to the occurrence of a particular predetermined combination of elements, e.g., a particular indicia of the wheels 10. In a preferred embodiment, the particular predetermined combinations that advance the racing element are non-winning outcomes in the conventional slot game (Col. 3:45-51). The reason for this configuration is that it “adds excitement and interest to continuing the play of the game since a player has an opportunity to win the race even if the slot machine does not pay during any particular pull of the handle 14.” (Col. 3:51-55).

Section D (Col. 3:56-4:7): Independent Payout for the Secondary Racing Game

Section D describes the timer 24 counting down as the player continues to play the conventional slot game. If the horse 22 reaches the Win, Place, or Show line before the timer 24 runs out, different payouts are awarded.

**Seelig Does Not Disclose a “Second Payout for a First Event” or “Providing a Retroactive Payment for a First Event.”**

The differences between the cited passages of Seelig and the limitations of Claim 17 are apparent. The Office Action relies on Section B as disclosing “determining a first event that occurs during play of a gaming device, e.g., paying winning outcome of slot game;” i.e., a conventional winning outcome at slot machine 10.

However, the Office Action then cites Sections A and C as generally disclosing “determining a first payout for the first event; providing the first payout to a player associated with the first event; determining a second event

that occurs during play of the gaming device, the second event occurring at a time after a time at which the first event occurs, e.g., the racing game.”

However, these sections do not disclose “determining a first payout.” It appears that the Office Action is relying on the “particular predetermined combination” (Col. 3:40, Section C) that advances the racing element as meeting the limitation of a “second event.” However, if the conventional winning outcome at slot machine 10 is interpreted as the “first event,” the only disclosure of a payout for the first event is the conventional “monetary payout” at Col. 3:37 in Section B. Sections A and C do not disclose any payout whatsoever.

The Office Action relies on Section D as disclosing “determining a second payout for the first event, based on the subsequent occurrence of the second event; and providing the second payout to a player associated with the first event.” Again, however, the only payout for the “first event,” i.e., the conventional slot game, is found in Section B at Col. 3:37. Section D discloses a payout for the second event, i.e., winning the racing game, at Col. 3:65-4:7, but this has no relation to the first event whatsoever. Seelig specifically states that there is preferably no overlap between conventional winning outcomes and outcomes that advance the racing element 22. (Col. 3:45-51). Even if there were overlap, there is no disclosure, teaching or suggestion that the payout for the racing game has any relationship to a winning outcome of the conventional game.

Finally, the Office Action relies on Sections A, C and D as together disclosing “providing a retroactive payout for the first event,” but as Applicants have demonstrated, if the Office Action interprets the first event as a winning outcome in a conventional slot game, the only payout for the

first event disclosed by Seelig is found in Section B, describing a conventional “monetary payout” for a conventional winning outcome (Col. 3:33-39.

Any rejection of Claim 17 under §103(a) similarly fails. Seelig specifically teaches away from any configuration in which conventional winning outcomes and outcomes that advance the secondary game overlap. (Col. 3:45-51). Seelig explicitly states that “[p]referably, the particular combination of indicia on the wheels . . . that provide the player with a monetary payout [i.e., the conventional winning outcome] is not a combination that moves the racing element.” *Id.* There is a specific disconnect between the conventional and secondary game in Seelig that points out why it is undesirable to include outcomes that advance both the conventional and secondary games, noting that “[t]his adds excitement and interest to continuing the play of the game since a player has an opportunity to win his race even if the slot machine does not pay during any particular pull of the handle.” *Id.*

Therefore, Seelig, alone or in combination with other prior art references, cannot be modified to meet the limitations of Claim 17 without rendering Seelig unable to perform its intended purpose, i.e., prolonging play by preventing overlap between favorable outcomes in different games. *See* MPEP §2145 (Sec. X(D)); §2141.02(VI) (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). In any event, any §103(a) rejection of Claim 17 would constitute a new ground of rejection and must be made final.

Accordingly, Seelig fails to disclose, teach or suggest all the limitations of the Claim 17. Claims 18 and 19 depend from claim 17 and are allowable for at least the same reasons as claim 17. Claim 20 recites an apparatus configured to perform a method having the same steps as claim 17 and is allowable for at least the same reasons as claim 17.

Therefore, the rejections of claims 17-20 should be withdrawn and the claims allowed.

**CONCLUSION**

For the reasons stated above, the rejections of claims 17-20 should be withdrawn and the claims allowed.

Please charge any fees that may be necessary for this submission, as well as any fees that may be necessary for any submissions during the pendency of this Application, as follows:

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Respectfully submitted,

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Date

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